

REMARKS

I. Specification

The Examiner objected to the disclosure because of the following informalities:

Regarding claim 24, the examiner suggested that claim dependency be changed to claim 28, rather than claim 20. Applicant has amended claim 24 accordingly.

Regarding claim 25, the examiner suggested that claim dependency be changed to claim 28, rather than claim 20. Applicant has amended claim 25 accordingly.

II. Claim Rejections - 35 USC §102(e).

Requirements for Prima Facie Anticipation

A general definition of *prima facie* unpatentability is provided at 37 C.F.R.

§1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, the reference cited by the Examiner must disclose each element

Patent Application Serial No. 10/759,681

recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a prima face case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

Levine.

The Examiner rejected claims 20-38 under 35 U.S.C. §102(e) as being anticipated by Levine (U.S. Patent Application No. 2004/0205462 A1).

Examiner states that the published Levine application discloses a book file generator, a common normal format converter, a book file memory, an equipment specific format file converter and a book reproducer. Claim 20 has been amended to read as follows:

A print-on-demand system for creating and reproducing books by heterogeneous reproduction workflows, said system comprising:

at least one of a scanner, memory and data network for obtaining book contents for a book targeted for reproduction;

a book file generator adapted to generate a digital representation of said book targeted for reproduction into book files including book identification information and book production information in job definition format (JDF);

Patent Application Serial No. 10/759,681

a common normal format converter adapted to convert said book files into a common normal format that is reproduction system- and solution-independent;

a book file memory adapted to store common normal format files representing said book targeted for reproduction as a mastered book;

an equipment specific format file converter adapted to convert common normal format files into a equipment specific format files including JDF definitions matching the needs of a book reproduction equipment being utilized to reproduce the book; and

a book reproducer adapted to reproduce the book from information comprised by the equipment specific format files.

Applicant respectfully submits that his prior patent application (Levine) does not teach "book files including book identification information and book production information in job definition format (JDF)" or "an equipment specific format file converter adapted to convert common normal format files into equipment specific format files including JDF definitions matching the needs of book reproduction equipment". Because of these distinctions, the Levine reference does not teach "a common normal format converter adapted to convert said book files [including book identification information and book production information in job definition format (JDF)] into a common normal format that is reproduction system and solution-independent."

Levine does not disclose all of the limitations of the amended claims 1 and 10 and therefore does not anticipate the Applicant's claims. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §102(e) rejection of claim

Patent Application Serial No. 10/759,681

20-38 based on the Levine patent publication reference be withdrawn, as Levine does not disclose each and every limitation of the Applicant's claims.

III. Claim Rejections - 35 USC §103.

Claims 1-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Levine `462 in view of Warmus (US 6,332,149). The rejection is respectfully traversed.

Examiner states that Levine `462 discloses a method comprising the steps of receiving as book files a digital representation of a book targeted for reproduction, converting said book files including identification information into common normal format (CNF) files that are solution-independent, storing the CNF files as a mastered book, converting the CNF files into equipment specific format files matching the need of a book reproduction system and reproducing the book from information comprising equipment specific format files. Claim 1 has been amended to read:

A print-on-demand method for creating and reproducing books by heterogeneous systems, said method comprising the steps of:

a) obtaining book files in job definition format (JDF) from at least one of a memory, scanner and network, said book files including book identification information and book production information, wherein said book files are compiled into a digital representation of a book targeted for reproduction;

b) converting said book files from JDF into a master book embodied in common normal format (CNF) files that are reproduction system- and solution-independent;

c) storing the CNF files in memory as a mastered book;

Patent Application Serial No. 10/759,681

- d) converting the CNF files into equipment specific format files including JDF definitions that match the needs of a book reproduction system; and
- e) reproducing said book with said equipment specific format files at said book reproduction system.

Applicant respectfully submits that Levine `462 in view of Warmus `149 does not hint at, teach or suggest the step of "obtaining book files in job definition format (JDF) from at least one of a memory, scanner and network, said book files including book identification information and book production information, wherein said book files are compiled into a digital representation of a book targeted for reproduction." Furthermore, Levine `462 in view of Warmus `149 does not hint at, teach or suggest "converting said book files from JDF into a master book embodied in common normal format (CNF) files that are reproduction system- and solution-independent" and " converting the CNF files into equipment specific format files including JDF definitions that match the needs of a book reproduction system".

Because Levine `462 in view of Warmus `149 fail to hint at, teach or suggest what is now found in independent claim 1, as amended, claims 1-19 are no longer unpatentable under 35 U.S.C. §103. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 20-38 based on the Levine patent publication reference be withdrawn.

Patent Application Serial No. 10/759,681

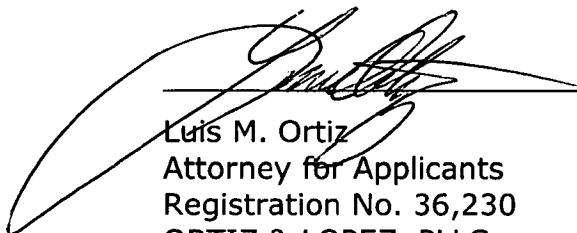
IV. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §102 and §103 based on the preceding remarks. Reconsideration and allowance of Applicant's claims 1-38 is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

Dated: February 3, 2008

A handwritten signature in black ink, appearing to read 'Luis M. Ortiz', is written over a horizontal line.

Luis M. Ortiz
Attorney for Applicants
Registration No. 36,230
ORTIZ & LOPEZ, PLLC
P.O. Box 4484
Albuquerque, NM 87196-4484